REMARKS/ARGUMENTS

The present Amendment is in response to the Final Office Action having a mailing date of May 16, 2006. Claims 1-14 are pending in the present Application. Applicant has canceled claims 5 and 10. Consequently, claims 1-4, 5-9, and 11-14 remain pending in the present Application.

Applicant has canceled claims 5 and 10, which recited that the partition is lockable from the operating system. Applicant notes that the independent claims 1 and 6 currently recite that the partition is lockable. Consequently, claims 5 and 10 are redundant. Thus, Applicant respectfully submits that no new matter is added and no new search is required.

This application is under Final Rejection. Applicant has presented arguments hereinbelow that Applicant believes should render the claims allowable. In the event, however, that the Examiner is not persuaded by Applicant's arguments, Applicant respectfully requests that the Examiner enter the Amendment to clarify issues upon appeal.

In the above-identified Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. § 103 as being unpatentable over Applicants admitted prior art (AAPA) in view of IBM Technical Disclosure Bulletin TDB-ACC-NO: NN9611103 (Bulletin). In so doing, the Examiner acknowledged that the AAPA does not expressly disclose "utilizing a basic input output system (BIOS) of the computer system," and allowing a password to be provided for each of the sub-partitions as recited in independent claims 1 and 6. With respect to Applicant's arguments, the Examiner indicated that the partition being nonviewable and lockable from the operating system was disclosed in the AAPR. The Examiner also disagreed with Applicant's arguments relating to the boot manager. In particular, in the above-identified Office Action, the Examiner indicated that the disclosure in the Bulletin of the BootManager

does not mean that a separate boot manager that may query the user later in the boot process is necessary. This only implies that the BootManager is used as sort of [an] interface to prompt the user to enter a password for that particular partition. This kind of facility is also required in the applicant['s] invention so that the user is prompted and the user provides the sub-partition password and the user provides the sub-partition password and [sic] be able to boot from the sub-partition.

Applicant respectfully traverses the Examiner's rejection. Independent claim 1 recites a method for providing a trusted boot source, which allows a plurality of sub-partitions to be defined for the partition and provides a password for each of the sub-partitions. The password is required for a user to utilize a corresponding sub-partition as a boot source. Furthermore, the password is queried for using the BIOS. The partition is defined to be nonviewable and lockable from the operating system. Claim 6 recites an analogous computer system.

Independent claims 1 and 6 also recite that the partition, of which the subpartitions are part, is lockable and nonviewable from the operating system. The partition may be considered to be analogous to a PARTIES (protected area run time interface extension services) partition. Claims 1 and 6 also recite that a password is required for each sub-partition by the BIOS of the computer system. As a result, subpartitions of the nonviewable and lockable partition may be accessed via passwords obtained by BIOS, which is active during preboot, at the initiation of startup of the computer system.

The AAPA in view of the Bulletin fail to teach or suggest utilizing the BIOS for providing a password for sub-partition(s) of a partition that is nonviewable and lockable from the operating system. As the Examiner has acknowledged, although the AAPA describes booting from different sub-partitions and PARTIES partitions, the AAPA fails to teach or suggest the use of passwords.

The Bulletin does describe the use of passwords for booting partitions. Although it functions well for its intended purpose, the Bulletin describes using an additional utility, the BootManager, to use the passwords. The Bulletin specifically states that "Often a utility, such as a

BootManager, is employed to partition the hard disk such that different operating systems can be selected at boot time. An example of such a configuration is DOS/Windows for the children to play games on in one partition and something else such as OS/2* Warp for the parents in another partition." The Bulletin goes on to state that "[t]he solution proposed . . . is to add a feature *to the likes of BootManager* such that when the desired partition is selected, the user is prompted to enter a password for that partition before booting commences." Emphasis added. Thus, the Bulletin describes adding a feature to an existing utility, such as a boot manager. Applicant has found no indication that the described BootManager is merely a "user interface" as suggested by the Examiner. Instead, the BootManager is apparently a utility as described in the Bulletin.

If the AAPA and the Bulletin were combined, then the combination might add a feature to the BootManager. This feature would allow the BootManager (or other utility) to request a password for a particular partition before booting the partition. However, because such a feature is part of a utility, the utility including the additional feature has booted. Consequently, Applicant respectfully submits that booted code from the hardfile would be used to request a password and validate the password provided. Stated differently, booted code from the hardfile (e.g. the BootManager) makes the determination whether to ask for passwords, queries the user for such passwords, and validates these passwords. Because the BootManager is a utility that is presumably booted code from the hardfile, these activities of the BootManager occur after the preboot. Consequently, the passwords are for a partition that is available after preboot. Such a partition would be viewable from the operating system. In contrast to the method and system recited in claims 1 and 6, therefore, the combination of the AAPA and the Bulletin provide passwords for partitions that are viewable from the operating system.

The disclosure in the AAPA of a nonviewable partition does not change this conclusion.
Because the passwords would be requested and validated through a utility, the combination of the
AAPA and the Bulletin would not provide passwords a partition during preboot. Thus, the
combination would provide passwords for a viewable partition, not a nonviewable partition.
Applicant notes that most inventions arise from a combination of old elements and each element
may often be found in the prior art. Rouffett, 149 F.3d at 1357. However, mere identification in
the prior art of each element is insufficient to defeat the patentability of the combined subject
matter as a whole. Id. at 1355, 1357. Thus, although a nonviewable partition is described in the
AAPA, the combination of the AAPA and the Bulletin fails to teach or suggest the method and
system recited in claims 1 and 6.

Moreover, the passwords would be provided using the BootManager utility, rather than
using BIOS, during preboot, as recited in claims 1 and 6. As discussed above, the Bulletin
describes a utility that requests and validates passwords. Such a utility would presumably be
booted from the hardfile, rather than being part of BIOS. Applicant has found no indication that
such a utility would be incorporated into BIOS. Furthermore, Applicant can find no indication in
the Bulletin that such a utility is a user interface, as suggested by the Examiner, that is
incorporated into BIOS. Applicant respectfully submits that the conclusion that the
BootManager corresponds to a user interface that may be provided using the BIOS recited in
claims 1 and 6 involves improper hindsight. One "cannot use hindsight reconstruction to pick
and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re
Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). See also In re Fritch, 23 USPQ2d 1780,1783 (Fed.
Cir. 1992). Consequently, the combination of the AAPA and the Bulletin would still fail to teach
utilizing BIOS to provide passwords for nonviewable and lockable partitions. Thus, the AAPA

in combination with the Bulletin fails to teach or suggest the method and system recited in claims 1 and 6. Accordingly, Applicant respectfully submits that claims 1 and 6 are allowable over the cited references.

Claims 2-4, and 11-12 depend upon claim 1. Claims 7-9, and 13-14 depend upon claim 6. Consequently, the arguments herein apply with full force to claims 2-4, and 7-9 and 11-14. Accordingly, Applicant respectfully submits that claims 2-4 and 7-9, and 11-14 are allowable over the cited references.

Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

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Date

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